

RESPONSE under 37 C.F.R. § 1.111  
U.S. Appln. No. 09/745,923

### **REMARKS**

Claims 1-16 and 21-22 are all the claims pending in the application and stand finally rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the foregoing amendments and following remarks.

### **CLAIM REJECTIONS.**

#### **35 U.S.C. § 103**

Claims 1-16 and 21-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable by U.S. Patent Application 20030210199 to Sward et al. (hereinafter Sward) in view of U.S. Patent 5,898,933 to Kaschke. Applicant respectfully traverses this rejection for the following reasons.

Sward has an effective priority date of September 8, 2000 (U.S. Patent 6,545,643). Applicant conceived and diligently reduced to practice the invention of the instant application prior to the Sward priority date as shown by the inventors declarations under 37 C.F.R. § 1.131 and supporting evidenced attached hereto as Appendix A. Accordingly, Applicant believes Sward is not considered prior art within the meaning of 35 U.S.C. § 102 and thus the §103 rejection relying on Swords should be withdrawn.

In view of the foregoing, reconsideration and withdrawal of the §103 rejection based on the combination of Sward and Kaschke is respectfully requested.

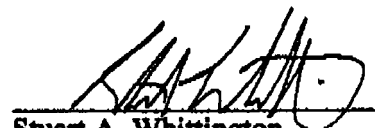
### **CONCLUSION.**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. Applicant

RESPONSE under 37 C.F.R. § 1.111  
U.S. Appl. No. 09/745,923

hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to **Deposit Account # 50-0221.**

Respectfully submitted,



Stuart A. Whittington  
Registration No. 45,215  
Intel Corporation  
(480) 715-3895

c/o  
Blakely, Sokoloff, Taylor & Zafman, LLP  
12400 Wilshire Blvd., Seventh Floor  
Los Angeles, CA. 90025-1026  
(503) 264-0967

Date: August 8, 2005

**APPENDIX A**

**DECLARATION UNDER 37 C.F.R. § 1.131  
U.S. Appln. No. 09/745,923**

Sir:

This Appendix includes three individual declarations under 37 C.F.R. § 1.131 of the inventors of the present application (6 pages total) as well as one copy of the supporting documentation referenced by the declarations "the attached Exhibit" (4 pages total).

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JUL 08 05 06:53a

Jarvis Tou

(858) 385-9191

p.2

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FACSIMILE TRANSMITTED TO THE U.S. PATENT AND TRADEMARK OFFICE (FAX NO. 571-273-8300) ON THE DATE INDICATED BELOW:

Date of Transmission: 8/8/2005 By: [Signature]

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Jarvis Tou et al.

Atty. Docket: 42390.P9432

Appln. Ser. No.: 09/745,923

Group Art Unit: 2684

Filed: December 22, 2000

Examiner: Trinh, Tan H.

For: COMMUNICATION MODULE WITH RETRACTABLE ANTENNAE AND METHOD THEREFOR

**DECLARATION UNDER 35 CFR §1.131  
OF JARVIS TOU**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I, Jarvis C. Tou, hereby declare that:

1. I am a citizen of the United States of America, and currently reside at 18525 Aceituno St., San Diego, CA 92128
2. I was previously an employee of Intel Corporation.
3. The invention claimed in the above-referenced patent application was conceived at least as early as April 28, 2000, as evident by the enclosed "Intel Invention Disclosure" entitled "A method and apparatus for

Art Unit: 2684  
A/N: 09/745,923

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42390.P9432

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simultaneous antenna deployment and power control in a PC Card" (hereinafter "the attached Exhibit").

4. I was a co-author of the attached Exhibit.

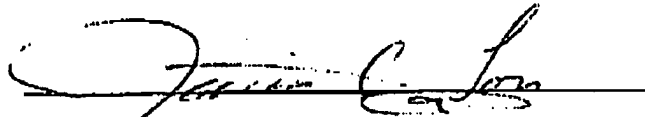
5. I have reviewed the attached Exhibit and believe it to be a true copy of the document I co-authored.

6. Since first conception of the invention described in the attached Exhibit, I and my co-inventors diligently pursued the invention including working with other Intel engineers to reduce the conceived invention into practice for a product scheduled for release in August of 2000, as well as working with Intel attorneys in preparing and filing the above-referenced patent application.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified patent application or any patent issued thereon.

Executed on this 8th day of July, 2005

By:

  
Jarvis C. Tou

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FACSIMILE TRANSMITTED TO THE U.S. PATENT AND TRADEMARK OFFICE (FAX NO. 571-273-8300) ON THE DATE INDICATED BELOW:

Date of Transmission: 8/8/05 By: [Signature]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Jarvis Tou et al.

Atty. Docket: 42390.P9432

Appln. Ser. No.: 09/745,923

Group Art Unit: 2684

Filed: December 22, 2000

Examiner: Trinh, Tan H.

For: COMMUNICATION MODULE WITH RETRACTABLE ANTENNAE AND METHOD THEREFOR

DECLARATION UNDER 35 CFR §1.131  
OF MARK DAVENPORT

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I, Mark D. Davenport, hereby declare that:

1. I am a citizen of the United States of America, and currently reside at 13080 Signature Point Road #88, San Diego, CA 92130
2. I was previously an employee of Intel Corporation.
3. The invention claimed in the above-referenced patent application was conceived at least as early as April 28, 2000, as evident by the enclosed "Intel Invention Disclosure" entitled "A method and apparatus for

Art Unit: 2684  
A/N: 09/745.923

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42390.P9432

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simultaneous antenna deployment and power control in a PC Card" (hereinafter "the attached Exhibit").

4. I was a co-author of the attached Exhibit.

5. I have reviewed the attached Exhibit and believe it to be a true copy of the document I co-authored.

6. Since first conception of the invention described in the attached Exhibit, I and my co-inventors diligently pursued the invention including working with other Intel engineers to reduce the conceived invention into practice for a product scheduled for release in August of 2000, as well as working with Intel attorneys in preparing and filing the above-referenced patent application.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified patent application or any patent issued thereon.

Executed on this 1 day of July 2005

By: 

Mark D. Davenport

Art Unit: 2604  
A/N: 09/745,923

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I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FACSIMILE TRANSMITTED TO THE U.S. PATENT AND TRADEMARK OFFICE (FAX NO. 571-273-8300) ON THE DATE INDICATED BELOW:

Date of Transmission: 8/8/05 By: [Signature]

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AUG 08 2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Jarvis Tou et al.

Atty. Docket: 42390.P9432

Appl. Ser. No.: 09/745,923

Group Art Unit: 2684

Filed: December 22, 2000

Examiner: Trinh, Tan H.

For: **COMMUNICATION MODULE WITH RETRACTABLE ANTENNAE AND METHOD THEREFOR**

**DECLARATION UNDER 35 CFR §1.131  
OF PAUL S. COLLINS**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I, Paul S. Collins, hereby declare that:

1. I am a citizen of the United States of America, and currently reside at 41295 Pine Tree Circle, Temecula, CA 92591.

2. I am currently an employee of Intel Corporation.

3. The invention claimed in the above-referenced patent application was conceived at least as early as April 28, 2000, as evident by the enclosed "Intel Invention Disclosure" entitled "A method and apparatus for

Art Unit: 2684  
A/N: 09/745,923

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simultaneous antenna deployment and power control in a PC Card" (hereinafter "the attached Exhibit").

4. I was a co-author of the attached Exhibit.

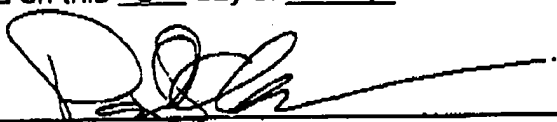
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I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified patent application or any patent issued thereon.

Executed on this 8 day of 07 2005

By:



Paul S. Collins

An Unit: 21584  
A/N: 09/745.823

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TOTAL P.03  
P.03

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## INTEL INVENTION DISCLOSURE

ATTORNEY-CLIENT PRIVILEGED COMMUNICATION

MAY - 4 2000

DATE: 4/8/00

Wireless / NBG/eWave

It is important to provide accurate and detailed information on this form. The information will be used to evaluate your invention for possible filing as a patent application. When completed and signed, please return this form to the Legal Department at JF3-147. If you have any questions, please call 264-0444.

1. Inventor: Tou Jarvis C  
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 City Phoenix State AZ Zip 85048 Country USA  
 \*Corporate Level Group (e.g. IABG, NCG, CEG) NBG Division eWave Subdivision  
 Supervisor\* Bill Atkinson WWID Phone (858) 385-4484 M/S: SN1-01

Inventor: Davenport Mark D  
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 Citizenship: USA WWID 10575265 Contractor: YES NO X  
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MAY 5 2000

Inventor: Collins Paul   
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 Citizenship: USA WWID 10575243 Contractor: YES NO X  
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 \*Corporate Level Group (e.g. IABG, NCG, CEG) NBG Division eWave Subdivision  
 Supervisor\* Mark Davenport WWID 10575265 Phone (858) 385-4551 M/S: SN1-01

PATENT DATABASE GROUP  
INTEL LEGAL TEAM

\*If you are unsure of this information, please discuss with your manager.

(PROVIDE SAME INFORMATION AS ABOVE FOR EACH ADDITIONAL INVENTOR)

2. Title of Invention: A method and apparatus for simultaneous antenna deployment and power control in a PC Card
3. What technology/product/process (code name) does it relate to (be specific if you can):  
Windances Personal Wireless PC Card
4. Include several key words to describe the technology area of the invention in addition to # 3 above: \_\_\_\_\_

August 1999

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\_\_\_\_ wireless, antenna, PC Card, power switch, power control \_\_\_\_\_

5. Stage of development (i.e. % complete, simulations done, test chips if any, etc.)

10% complete, in prototype hardware development

6. (a) Has a description of your invention been, or will it shortly be, published outside Intel:

NO: X YES: \_\_\_\_\_ If YES, was the manuscript submitted for pre-publication approval? \_\_\_\_\_

IDENTIFY THE PUBLICATION AND THE DATE PUBLISHED: \_\_\_\_\_

- (b) Has your invention been used/sold or planned to be used/sold by Intel or others?

NO: \_\_\_\_\_ YES: X DATE WAS OR WILL BE SOLD: August 2000

August 1999

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**ATTORNEY-CLIENT PRIVILEGED COMMUNICATION**

(c) Does this invention relate to technology that is or will be covered by a SIG (special interest group)/standard/ or specification?

NO: X YES: \_\_\_\_\_ Name of SIG/Standard/Specification: \_\_\_\_\_

(d) If the invention is embodied in a semiconductor device, actual or anticipated date of tapeout? N/A

(e) If the invention is software, actual or anticipated date of any beta tests outside Intel N/A

7. Was the invention conceived or constructed in collaboration with anyone other than an Intel blue badge employee or in performance of a project involving entities other than Intel, e.g. government, other companies, universities or consortia? NO: \_\_\_\_\_ YES: X Name of individual or entity: Flextronics Corp.

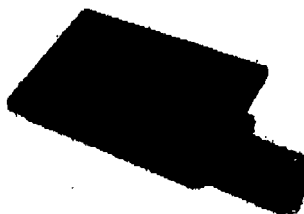
8. Is this invention related to any other invention disclosure that you have recently submitted? If so, please give the title and inventors: No

**PLEASE READ AND FOLLOW THE DIRECTIONS ON  
HOW TO WRITE A DESCRIPTION OF YOUR INVENTION**

**Please attach a description of the invention to this form, DATED AND SIGNED BY AT LEAST ONE PERSON WHO IS NOT A NAMED INVENTOR, and include the following information:**

1. **Describe in detail what the components of the invention are and how the invention works.**

An antenna contained in a PC card form factor that when deployed (ejectable, pop-out, swing-out, flip-out, etc.) will also trigger power to be applied to the enclosed circuits, including the radio, both mechanically and through software control. See figure below for a pop-out antenna illustration (preferred mode).



In this scenario, in order to use the device, a user would deploy the antenna (popped-out in above illustration) and the action would power-on the PC Card device through both a mechanical switch and setting appropriate software registers for a clean power-on sequence. Conversely, when the user has completed using the device, the antenna would be stowed (pushed-in in above illustration) and the PC Card device would both set the appropriate software registers for a clean power-down sequence, as well as switch off the power mechanically.

2. **Describe advantage(s) of your invention over what is done now.**

To definitively and mechanically power down or cut power to a PC Card today, it must be either ejected, or an externally accessible miniature switch must be implemented (no known examples). This allows a single action in deploying an antenna which is needed in a wireless PC Card device to simultaneously apply power. And in reverse, the stowage of the antenna simultaneously turns off the power.

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3. **YOU MUST include at least one figure illustrating the invention. If the invention relates to software, include a flowchart or pseudo-code representation of the algorithm.**

See above figure.

3. **Value of your invention to Intel (how will it be used?).**

Will be used for wireless PC Card products as a feature differentiator. Solves a concern from mobile PC users when they need to use a wireless PC Card. For example, wireless devices on board and airplane must be turned off during takeoff and landing. This invention helps assure that the radio is indeed turned off as the antenna will be stowed.

5. **Explain how your invention is novel. If the technology itself is not new, explain what makes it different.**

Antenna stowage assures radio is not emitting.

6. **Identify the closest or most pertinent prior art that you are aware of.**

none

7. **Who is likely to want to use this invention or infringe the patent if one is obtained and how would infringement be detected?**

PC Card manufacturers. Products would appear in the market, or during industry level interoperability testing.

**\*HAVE YOUR SUPERVISOR READ, DATE AND SIGN COMPLETED FORM**

DATE:

4/28/00

SUPERVISOR:



BY THIS SIGNING, I (SUPERVISOR) ACKNOWLEDGE THAT I HAVE READ AND UNDERSTAND THIS DISCLOSURE, AND RECOMMEND THAT THE HONORARIUM BE PAID

14/14